

Application No.: 10/037394

Case No.: 56059US009

Remarks

Applicant notes that the status of claim 14-15 was incorrectly identified as "original" even though amendment to these claims was concurrently requested. The Applicant assumes that the amendments were entered and the status of such claims is now "previously amended".

The Applicant respectfully requests that the finality of the rejection be withdrawn. According to the "Response to Arguments" on p.12 of the Office Action, it is stated that "Applicant's arguments with respect to the claims of record have been considered but are moot in view of the new ground(s) of rejection." Since Applicant has not previously had the opportunity to respond to the new ground(s) of rejection, the finality of the rejection is premature.

Rejections under 35 U.S.C. § 102 & Double Patenting

Claims 40-44 and 47 are rejected under 35 U.S.C. § 102(b) as being anticipated by Weber et al. (U.S. Patent No. 3,222,204).

Claims 40-44 and 47 are rejected under 35 U.S.C. § 102(e) as being anticipated by Schleifstein (U.S. Patent No. 6,153,671).

Claims 40-47 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 11, 12, 32-37 of copending Application No. 10/420,168.

In view of the cancellation of claims 40-47, these rejections are now moot.

Rejections under 35 U.S.C. § 103

Claims 40-45 and 47 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Morris et al. (U.S. Patent No. 6,204,971) in view of Weber et al. (U.S. Patent No. 3,222,204).

In view of the cancellation of claims 40-47, this rejection is now moot.

Claims 14, 15, 23, 24, 26, 27, 40-45 and 47-49 are rejected under 35 U.S.C. § 103 as being unpatentable over Weber et al. (U.S. Patent 3,222,204) in view of Diesslin et al. (U.S. Patent 2,567,011). Claims 14, 15, 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belisle et al (U.S. Patent No. 4,725,494) in view of Weber et al. (U.S. Patent 3,222,204) and Diesslin et al. (U.S. Patent 2,567,011). Claims 14, 15, 35, 36, 38 and 39 are rejected under 35

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U.S.C. 103(a) as being unpatentable over Morris et al. (U.S. Patent No. 6,204,971) in view of Weber et al. (U.S. Patent 3,222,204) and Diesslin et al. (U.S. Patent 2,567,011).

In view of the cancellation of claims 40-47, this rejection is now moot with regard to claims 40-45 and 47-49.

With regard to claims 14, 15, 23, 24, 26 and 27, The Examiner stated that Weber et al. does not explicitly illustrate a fluorocarbon surface treatment of claims 14 and 15. However, Weber et al. does explicitly teach that the compound may be an oleophobic fluorocarbon sizing agent as taught by U.S. Patent No. 2,567,011 (Diesslin et al.). The Examiner makes reference to column 6, lines 5-25.

However, at column 2, lines 27-30, Diesslin et al. teaches that "When the active group of a molecule is adsorbed at a surface the fluorocarbon chain can project outwardly a substantial distance to provide and exposed fluorocarbon "tail".

This teaching is consistent with the teaching of Weber et al. as well as Brice (U.S. Patent No. 2,732,398). Accordingly, the Applicant submits that one of ordinary skill in the art motivated to look to Diesslin et al. in light of the teachings Weber as well as the totality of analogous prior art teachings, would conclude that only those fluorocarbon acids and derivatives of Diesslin et al. having a substantial fluorocarbon tail would be suitable for use as a surface treatment for optical elements to induce float and not those having 1 to 4 perfluorinated carbon atoms as presently claimed.

The Applicant has responded to all the rejections set forth by the Examiner. Reconsideration and a timely allowance is respectfully requested.

Respectfully submitted,

12-10-03
Date

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